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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/371,769	08/10/99	HACKER	E 514413-3765

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HM12/0104

EXAMINER

PRYOR, A

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

01/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/371,769

Applicant(s)

Hacker et al

Examiner

Alton Pryor

Group Art Unit

1616



☒ Responsive to communication(s) filed on Dec 4, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-12 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 11 and 12 is/are allowed.

☒ Claim(s) 1, 2, and 4-10 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 3 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3,5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Detailed Action

Claim Rejections under 35 U.S.C. 112, 1st paragraph

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for synergistic compositions comprising specific A and B compounds in the specification based on data provided, does not reasonably provide enablement for combinations of A and B compounds where no data is provided . The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Examiner suggests that applicant limit claims to combinations of A plus B compounds that are supported by data in the specification.

Claim Rejections under 35 U.S.C. 112, 2nd paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-6,9,10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. Claim s 1,2,4-6,9,10 provides for the use of a herbicide composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1-6,9,10 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Regarding claim 1 line 23, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims Rejection under 35 U.S.C. 103(a)

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1,2,4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al (US 5,981,432; 11/9/99).

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Hudetz discloses synergistic compositions comprising glufosinate or its ammonium salt, S-metolachlor, and formulation auxiliaries. See abstract, column 5 lines 1-27. Hudetz discloses a method wherein the composition is applied pre- or post- emergence to cotton crops to control weeds. See column 1 lines 1-13, column 10 lines 37-45, column 11 lines 41-42, column 13 lines 52-60. Hudetz does not disclose the composition comprising said glufosinate, metolachlor, and auxiliaries further comprising a) metolachlor without a defined stereochemistry and b) pendimethalin. In absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use metolachlor without a defined stereochemistry. One having ordinary skill in the art would have been motivated to do this because similar structures would have been expected to deliver similar results. With respect to the composition not comprising pendimethalin, Hudetz further teaches that pendimethalin can be employed in a method to control weed growth in crops such as cotton. It would have been obvious to further modify the glufosinate composition to include pendimethalin. One would have been motivated to do this because both active ingredients, s-metolachlor and pendimethalin, are used to control weed growth in crops such as cotton.

8. Claims 1,2,4-6,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langelueddeke et al (EP 76470; 4/13/83).

Langelueddeke teaches a synergistic herbicide composition comprising glufosinate ammonium plus diuron. See abstract. Applicant must rewrite "use" claims as composition and/or method claims.

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Allowable Subject Matter

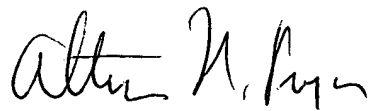
Claims 11 and 12 are allowable. The prior art does not suggest a synergistic composition comprising glufosinate ammonium plus cycloxydim. See unexpected data in Table 3 pages 32-33.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton Pryor whose telephone number is (703) 308-4691. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Alton Pryor

Patent Examiner, AU 1616

11/22/00